

## REMARKS

This communication is in response to the non-final Office Action dated November 14, 2003. The Examiner rejected claims 1-4, 6-21, and 23-31 under 35 U.S.C. § 103 in view of varying combinations of U.S. Patent Nos. 5,742,596 to Baratz et al. (Baratz), 6,307,853 to Storch et al. (Storch), and 5,726,984 to Kubler et al. (Kubler).

### Attorney Docket Number

The Applicants submitted a Revocation and Power of Attorney on October 31, 2001 indicating a change in representation and attorney docket number for this application. A Notice Regarding Power of Attorney, mailed on July 31, 2002, indicated that the Revocation and Power of Attorney was accepted. The Office Action, however, still indicates the previous attorney docket number. The Applicants respectfully request that the attorney docket number be changed from GGD-101 to 20014.0002.

### Interview

The Applicant thanks the Examiner for conducting a personal interview on December 2, 2003. During the interview, the Examiner and the Applicant's representative discussed the Baratz reference and the claims of the present invention. Specifics of the interview discussion are discussed below.

### New Reference

During the December 2 interview, the Examiner provided a new reference, U.S. Patent No. 6,169,734 to Wilson (Wilson). In keeping with the Applicant's duty of disclosure requirements, a Form PTO-1449 listing this reference is included herewith.

Claim Rejections Under 35 U.S.C. § 103

In sections 2-3 of the Office Action, the Examiner rejected claims 1-4, 6-21, and 23-31 under 35 U.S.C. § 103 in view of varying combinations of Baratz, Storch, and Kubler. Specifically, the Examiner rejected claims 1, 13, 19, 21, 27, and 28 in view of Baratz modified by Storch, and claims 6-10, 14-18, 23-25, and 29-31 in view of Baratz modified by Storch and Kubler.

It is well settled that for a rejection of a claim under 35 U.S.C. § 103 to be proper, each and every recitation of the claim must be present in the cited reference(s). See, for example, MPEP § 2143.03. It is also well settled that for a rejection of a claim under 35 U.S.C. § 103 to be proper, there must be some suggestion or motivation to modify a reference or combine reference teachings. See, for example, MPEP § 2143.01. When so modifying a reference, the proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. See, for example, MPEP § 2143.01. The modification must support a reasonable expectation of success with some degree of predictability. See, for example, MPEP § 2143.02. Finally, the source of the suggestion or motivation to modify a reference cannot be the Applicant's own disclosure. See, for example, MPEP § 2143. For at least the reasons stated below, the Examiner's rejections of the claims do not satisfy these burdens.

As its title indicates, Baratz discloses a "network based distributed PBX system." The network (37) of the PBX system (10) interconnects a group of users. Calls made from one user to another are transmitted in packet form over the network. However, calls made from a user to a location outside the network are depacketized and converted into analog voice data

for transmission onto PSTN telephone lines. (Col. 6, ll. 13-15) Thus, all outgoing calls are transmitted via PSTN lines rather than via a packet network.

In contrast to Baratz, the present invention discloses and claims a “telephone to packet adapter” for use in a home environment (not a telephony system including a PBX) or a method of using such an adapter. The adapter has a telephone interface for connecting to a telephone set. The adapter additionally has both a telephone line interface and a packet network interface. The adapter itself determines which calls are connected through the standard telephone line and which calls are connected through the packet network. Thus, the adapter allows a caller to be connected through a telephone line or through a packet network without requiring the presence of a PBX, a PC, a gateway, etc. Calls may be transmitted in packet form anywhere, not merely to another user within a limited group of users.

The controller circuit of the present invention is more than a generic processor as described in Baratz. Baratz is very specific as to the role of the processor. In accordance with the disclosure at, for example, column 2, lines 55-60, the Baratz processor is coupled to the codec, receives the digital voice data output by the codec, and forms packets of voice data therefrom. The controller circuit of the present invention is connected to the telephone line interface, the telephone interface, and the packet network interface, and contains an embedded software agent for routing an outgoing call, made from a user’s home telephone line, over the PSTN or the Internet. As described in the written description, the controller circuit can also provide other services, such as playing audio files. Furthermore, the controller circuit of the present invention includes the intelligent routing of these calls. There is no such notion of intelligent routing in the Baratz patent. Nor would it be obvious to include intelligent routing with the Baratz system since *all* outgoing calls are made over PSTN lines.

The Applicant respectfully traverses several statements made in the Examiner's rejection. Specifically:

- there is no disclosure or suggestion of an *adapter* as disclosed and claimed in the present invention;
- reference 41 is directed to a telephony client rather than a telephone to packet adapter (col. 4, lines 35-36);
  - there is no mention of using the Baratz system in a user's home, nor would it be obvious to do so since the Baratz system is a PBX and includes several servers, a network, host computers, routers, etc.;
  - reference 48 is directed to a hub/router rather than a telephone line interface (figure 1), and, as such, it is not configured to be connected to any telephone line, let alone a user's home telephone line;
  - reference 174 is directed to a telephony client module rather than a telephone interface (col. 4, lines 38-43);
    - reference 43 is directed to a network interface card installed in a host computer rather than a packet network interface as that term is used in the instant application (col. 4, lines 11-12);
      - reference 112 is directed to a processor rather than a controller circuit (col. 9, line 29), and the processor 112 does not interconnect a telephone line interface, a telephone interface, and a packet network interface; and
        - the processor 112 is not configured to route an outgoing call to either a telephone line or a packet network.

During the December 2 interview, the Examiners stated that the upper left corner of Baratz Figure 1 disclosed the present invention. However, as discussed above, there is no disclosure there or anywhere in Baratz of an adapter that can intelligently route calls made from a user's home telephone set to either a telephone line or a packet network.

During the December 2 interview, the Examiners pointed to column 7, lines 13-27 as disclosing functionality of the Baratz system of placing outgoing calls via a packet network. Specifically, the Examiners relied on the following language:

System 10 utilizes the voice capabilities of the internet and internet module 14 may be updated as new services and/or protocols are added to the internet.

Column 7, lines 16-18. Exactly what is meant by "voice capabilities of the internet" is not clear. At the time the present invention was made, the meaning of this language would be particularly puzzling. What *is* clear, however, is that *all* outgoing calls made from the Baratz system are transmitted in conventional analog form over standard PSTN lines:

*For outgoing external calls, the calling extension communicates with the telephony server module, since telephone lines 48 from PSTN 12 terminate within the telephony server module. The calling party's voice is digitized, packetized and placed onto network 37 by the telephony client module. The voice packets are addressed to the appropriate telephony server module.*

*Telephony server module depacketizes and converts the digital data into analog voice data for transmission onto telephone lines 48.*

Column 6, lines 7-15 (emphasis added).

Packets received by telephony server module 170 are depacketized by processor 70 and their contents undergo a digital to analog conversion by codecs 64. The analog voice signals are input to PSTN interfaces 62 for transmission to telephone lines 48.

Column 9, lines 1-5.

As stated above, it would not be obvious to include intelligent routing with the Baratz system since all outgoing calls are made over PSTN lines. While all of the Examiner's

rejections of the routing rules are improper, the rejection of the specific routing rule that the outgoing call is routed to the telephone line interface when a dialed telephone number is an emergency number is particularly troubling. In the rejection, the Examiner stated that:

It is well known in the art to routed [sic] emergency call over telephone line interface than over packet interface or LAN interface since the telephone line is known to be more reliable (i.e. call will not be drop [sic]) than packet interface or LAN interface.

The Examiner's statement is respectfully traversed. First, if it is well known, as proffered by the Examiner, the Examiner is respectfully requested to produce a reference evidencing this fact. Second, as evidenced by a recent article by Adam Raney entitled "VoIP and the 9-1-1 Solution," a copy of which is included herewith, solutions to the problem of how to handle emergency calls are *not* obvious. In fact, as discussed in the article, this issue has been a prominent subject of recent public hearings held by the Federal Communication Commission. The Applicant's claimed solution to this problem is novel and patentable, and the Examiner is respectfully requested to so indicate.

In view of the foregoing, it is seen that there is no disclosure or suggestion in the cited art, taken individually or collectively, of the adapter of the present invention. The rejections of the claims, therefore, are improper and must be withdrawn.

#### The Wilson Reference

As stated above, the Examiners cited a new reference, the Wilson reference, during the December 2 interview. Wilson appears to disclose an Internet phone providing standard voice and Internet audio functions using the familiar POTS platform. This device includes a connection to the PSTN. However, the use of this PSTN connection is by means of a modem data pump which offers access onto the Internet. Unlike the present invention, there is no

conventional connection to the PSTN. All audio and voice communication goes through the modem data pump onto the Internet.

Thus, the Wilson reference is inapposite to the present application.

Newly Added Claims

The Applicant has added new claims 33-38. Consideration and allowance of these new claims is respectfully requested. It is noted that the Applicant has previously paid for one independent and two dependent claims that have since been canceled. Thus, the only charges associated with these new claims is the fee for presenting three claims in excess of twenty.

Extended Prosecution

As explained during the December 2, 2003 interview, the instant patent application has been pending for over five years and the Applicant has received six Office Actions. Each time the Applicant explains how a particular cited reference does not apply to the present invention, the Examiners respond by citing another similar reference. Should the Examiners feel that another Office Action citing another new reference is required, they are kindly asked to contact the Applicants undersigned representative beforehand in an effort to address any concerns the Examiners may have and to bring the application to allowance.

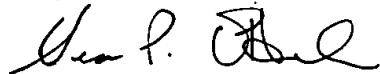
Additional Fees

The Commissioner is hereby authorized to charge any insufficiency, including a \$54 fee for presenting three additional claims, or credit any overpayment associated with this application to Swidler Berlin Shreff Friedman, LLP Deposit Account No. 19-5127 (order no. 20014.0002).

Conclusion

Claims 33-38 have been added. Claims 1-4, 6-21, 23-31, and 33-38 are pending in the application, and are believed to be in condition for allowance. In view of the foregoing, all of the Examiner's rejections of the claims are believed to be overcome. The Applicant respectfully requests reconsideration and issuance of a Notice of Allowance for all claims. Should the Examiner feel further communication would help prosecution, the Examiner is urged to call the undersigned at the telephone number provided below.

Respectfully Submitted,



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